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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,868	12/31/2001	Seng Beng Ho	217905US-6CONT	4293
22850	7590	08/02/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ARSHAD, UMAR	
			ART UNIT	PAPER NUMBER
			2174	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/029,868	HO, SENG BENG	
	Examiner	Art Unit	
	Umar Arshad	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20,21,and23-28 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 recites the limitations "said left vertical edge of said left side book thickness image" in lines 7 and 8 and "said right vertical edge of said right side book thickness image" in lines 9 and 10. There is insufficient antecedent basis for these limitations in the claim.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,340,980.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claims(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 20 is generic to the method recited in claim 1 of U.S. Patent No. 6,340,980. That is, claim 1 of U.S. Patent No. 6,340,980 falls entirely within the scope of claim 1, or, in other words, claim 20 is anticipated by claim 10 of U.S. Patent No. 6,340,980.

Specifically, the limitation "showing said thickness image of pages to move across the book image from right to left if the jump position is within the right portion of said thickness image, showing said thickness image of pages to move across the book image from left to right if the jump position is within the left portion of said thickness

image" recited in U.S. Patent No. 6,340,980 is a species of the limitation "displaying pages flipping from at least one of right-to-left and left-to-right" of the current application.

Also, the limitation "displaying a thickness image of said book image corresponding to an amount of said information on a left side and a right side of said display screen, a left portion of said thickness image displayed on said left side of said screen being proportional to a first amount of the information preceding a point in said set of information currently being displayed and a right portion of said thickness image displayed on said right side of said display screen being proportional to a second amount of information following the point in said set of information currently being displayed" recited in U.S. Patent No. 6,340,980 is a species of "displaying at least one of a right side book thickness image with a thickness proportional to a number of pages on a book right side, and a left side book thickness image with a thickness proportional to a number of pages on a book left side".

Finally, by claiming the limitations of "displaying a thickness image of said book image corresponding to an amount of said information on a left side and a right side of said display screen, a left portion of said thickness image displayed on said left side of said screen being proportional to a first amount of the information preceding a point in said set of information currently being displayed and a right portion of said thickness image displayed on said right side of said display screen being proportional to a second amount of information following the point in said set of information currently being displayed" and "displaying a thickness image of pages skipped over in said jumping step to the jump position in the said set of information, showing said thickness image of

pages to move across the book image from right to left if the jump position is within the right portion of said thickness image, showing said thickness image of pages to move across the book image from left to right if the jump position is within the left portion of said thickness image, and said thickness being proportional to the number of pages skipped over in said jumping step” in claim 1 of U.S. Patent No. 6,340,980, the limitation “at least one of a right side book thickness image and a left side book thickness image configured to increase or decrease in thickness in proportion to a number of pages added or removed, respectively” of the current application is covered.

Therefore, the species or sub-genus claimed in the conflicting patent anticipate the claimed genus in the current application and a patent to the genus would therefore extend the rights of the species or sub-genus should the genus issue as a patent after the species or sub-genus.

Claims 21, 23, 24 and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of Ho, U.S. Patent No. 6,340,980 in view of Knowlton, U.S. Patent No. 5,283,864.

Claim 1 of 6,340,980 is the same as claim 20 of the application except for the limitations designating one or more predefined behaviors: displaying pages flipping from at least one of right-to-left and left-to-right; displaying at least one of a right side book thickness image with a thickness proportional to a number of pages on a book

right side, and a left side book thickness image with a thickness proportional to a number of pages on a book left side, said at least one of a right side book thickness image and a left side book thickness image configured to increase or decrease in thickness in proportion to a number of pages added or removed, respectively.

However, Knowlton teaches displaying pages flipping from at least one of right-to-left and left-to-right (see Knowlton, column 2, lines 19 – 29); displaying at least one of a right side book thickness image with a thickness proportional to a number of pages on a book right side, and a left side book thickness image with a thickness proportional to a number of pages on a book left side, said at least one of a right side book thickness image and a left side book thickness image configured to increase or decrease in thickness in proportion to a number of pages added or removed, respectively (see Knowlton, figures 2A – 2C, items 35 and 39 and column 7, lines 21 – 49). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Knowlton with the invention of Ho in order to provide a more intuitive display to the user.

As per claim 23, Knowlton teaches the method of Claim 21, wherein: said finger-bookmark disappears when a bookmarked page is revisited (see Knowlton, column 13, lines 31 – 35); and said permanent bookmark does not disappear when a permanently bookmarked page is revisited (see Knowlton, figure 2F, the tabs do not disappear when their corresponding page is displayed).

As per claim 24, Knowlton teaches the method of Claim 20, further comprising: displaying a jump cursor on the said at least one of a right side book thickness image and a left side book thickness image (see Knowlton, figure 2E, items 49), said jump cursor being user-activated and identifying a jump position corresponding to a page to be displayed after a jump operation (see Knowlton, column 2, lines 42 – 61).

As per claim 28, Knowlton teaches the method of Claim 24, further comprising the step of: displaying a thickness image of pages skipped in said jumping step; displaying said thickness image of pages skipped moving across the book image from right to left if the jump position is within the right side thickness image; and displaying said thickness image of skipped pages moving across the book image from left to right if the jump position is within the left side thickness image; wherein said thickness image of pages skipped is proportional to a number of pages skipped in said jumping step (see Knowlton, column 7, line 50 – column 8, line 22).

Claims 25 – 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Ho, U.S. Patent No. 6,340,980 in view of Knowlton, U.S. Patent No. 5,283,864 and Henckel et al., U.S. Patent no. 5,463,725.



As per claim 25, Ho teaches the method of claim 20 as described above.

Knowlton teaches the method of Claim 20, further comprising: displaying two flipping pages simultaneously (see Knowlton, figure 2B and column 8, line 47 – column 9, line 7), said two flipping pages showing information from corresponding parts of said set of information while flipping (see Knowlton, column 8, line 63 – column 9, line 7).

Ho and Knowlton do not teach displaying more than two flipping pages simultaneously. Henckel teaches displaying more than two flipping pages simultaneously (see Henckel, figure 4, pages 103, 103, 256 and 257 and column 4, lines 25 – 36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Henckel with the method of Ho and Knowlton in order to provide page location information.

As per claim 26, Ho teaches the method of claim 20 as described above.

Knowlton teaches the method of claim 20, further comprising freezing a number of flipping pages in an act of flipping across the computer screen (see Knowlton, column 9, lines 28 – 33).

Ho and Knowlton do not teach freezing a number of flipping pages in an act of flipping across the computer screen in response to receiving a freeze command issued by a user. Henckel teaches freezing a number of flipping pages in an act of flipping across the computer screen in response to receiving a freeze command issued by a user (see Henckel, column 3, lines 5 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Henckel with the method of Ho and Knowlton in order to provide a more intuitive and realistic user interface.

As per claim 27, Ho teaches the method of claim 20 as described above.  
Knowlton further teaches the method of Claim 20, further comprising:

freezing a number of flipping pages in an act of flipping across the computer screen (see Knowlton, column 9, lines 28 – 33).

Ho and Knowlton do not teach freezing a number of flipping pages in an act of flipping across the computer screen in response to receiving a freeze command issued by a user. Henckel teaches freezing a number of flipping pages in an act of flipping across the computer screen in response to receiving a freeze command issued by a user (see Henckel, column 3, lines 5 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Henckel with the method of Ho and Knowlton in order to provide a more intuitive and realistic user interface.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 23, 24, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Knowlton, U.S. Patent No. 5,283,864.

As per claim 20, Knowlton teaches a method for displaying information in an electronic book configured to display flipping pages, comprising the steps of:

displaying pages flipping from at least one of right-to-left and left-to-right (see Knowlton, column 2, lines 19 – 29);

displaying at least one of a right side book thickness image with a thickness proportional to a number of pages on a book right side, and a left side book thickness image with a thickness proportional to a number of pages on a book left side, said at least one of a right side book thickness image and a left side book thickness image configured to increase or decrease in thickness in proportion to a number of pages added or removed, respectively (see Knowlton, figures 2A – 2C, items 35 and 39 and column 7, lines 21 – 49).

As per claim 21, which is dependent on claim 20, Knowlton teaches the method of claim 20. Knowlton further teaches the method of Claim 20, further comprising at least one of:

displaying one of a finger bookmark (see Knowlton, figure 4, item 55) and a permanent bookmark (see Knowlton, figure 2E, items 49); and  
jumping to a jump position corresponding to said one of a finger-bookmark (see Knowlton, column 13, lines 23 – 30) and a permanent bookmark (see Knowlton, column 2, lines 42 – 61).

As per claim 23, which is dependent on claim 21, Knowlton teaches the method of claim 21. Knowlton further teaches the method of Claim 21, wherein:

said finger-bookmark disappears when a bookmarked page is revisited (see Knowlton, column 13, lines 31 – 35); and

said permanent bookmark does not disappear when a permanently bookmarked page is revisited (see Knowlton, figure 2F, the tabs do not disappear when their corresponding page is displayed).

As per claim 24, which is dependent on claim 20, Knowlton teaches the method of claim 21 (see rejection above). Knowlton further teaches the method of Claim 20, further comprising:

displaying a jump cursor on the said at least one of a right side book thickness image and a left side book thickness image (see Knowlton, figure 2E, items 49),

said jump cursor being user-activated and identifying a jump position corresponding to a page to be displayed after a jump operation (see Knowlton, column 2, lines 42 – 61).

As per claim 28, which is dependent on claim 24, Knowlton teaches the method of claim 24 (see rejection above). Knowlton further teaches the method of Claim 24, further comprising the step of:

displaying a thickness image of pages skipped in said jumping step;

displaying said thickness image of pages skipped moving across the book image from right to left if the jump position is within the right side thickness image; and

displaying said thickness image of skipped pages moving across the book image from left to right if the jump position if within the left side thickness image;

wherein said thickness image of pages skipped is proportional to a number of pages skipped in said jumping step (see Knowlton, column 7, line 50 – column 8, line 22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton, U.S. Patent No. 5,283,864 in view of Henckel et al., U.S. Patent no. 5,463,725.

As per claim 25, which is dependent on claim 20, Knowlton teaches the method of claim 20 (see rejection above). Knowlton further teaches the method of Claim 20, further comprising: displaying two flipping pages simultaneously (see Knowlton, figure 2B and column 8, line 47 – column 9, line 7), said two flipping pages showing information from corresponding parts of said set of information while flipping (see Knowlton, column 8, line 63 – column 9, line 7).

Knowlton does not teach displaying more than two flipping pages simultaneously. Henckel teaches displaying more than two flipping pages simultaneously (see Henckel, figure 4, pages 103, 103, 256 and 257 and column 4, lines 25 – 36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Henckel with the method of Knowlton in order to provide page location information.

As per claim 26, which is dependent on claim 20, Knowlton teaches the method of claim 20 (see rejection above). Knowlton further teaches method of Claim 20, further comprising:

displaying flipping pages simultaneously as a document browsing speed is increased (see Knowlton, column 8, line 47 – column 9, line 33).

Knowlton does not teach displaying increasingly more flipping pages. Henckel teaches displaying increasingly more flipping pages as document browsing speed is increased (see Henckel, column 4, lines 37 – 44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Henckel with the method of Knowlton in order to provide a more intuitive and realistic user interface.

As per claim 27, which is dependent on claim 20, Knowlton teaches the method of claim 20 (see rejection above). Knowlton further teaches the method of Claim 20, further comprising:

freezing a number of flipping pages in an act of flipping across the computer screen (see Knowlton, column 9, lines 28 – 33).

Knowlton does not teach freezing a number of flipping pages in an act of flipping across the computer screen in response to receiving a freeze command issued by a user. Henckel teaches freezing a number of flipping pages in an act of flipping across the computer screen in response to receiving a freeze command issued by a user (see Henckel, column 3, lines 5 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Henckel with the method of Knowlton in order to provide a more intuitive and realistic user interface.

### ***Allowable Subject Matter***

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Arshad whose telephone number is (703) 305-0329. The examiner can normally be reached on Monday - Friday, 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (703) 308-0640. The fax phone




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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SECTION 101  
PATENT EXAMINER